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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|--|-------------|----------------------|---------------------------|------------------------|
| 09/731,651   | 12/07/2000  | Jerry Walter Malcolm | AUS9-2000-0655-US1        | 9971                   |
| 45371 7590 05/01/2007<br>IBM CORPORATION (RUS)<br>c/o Rudolf O Siegesmund Gordon & Rees, LLp<br>2100 Ross Avenue<br>Suite 2600<br>DALLAS, TX 75201 |             |                      | EXAMINER<br>STORK, KYLE R |                        |
|  |             |                      | ART UNIT<br>2178          | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>05/01/2007   | DELIVERY MODE<br>PAPER |

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/731,651  
Filing Date: December 07, 2000  
Appellant(s): MALCOLM ET AL.

MAY 01 2007

**Technology Center 2100**

Rudolf O. Siegesmund  
Reg. No. 37,720  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 January 2007 appealing from the Office action mailed 9 November 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|         |                |         |
|---------|----------------|---------|
| 6589290 | Maxwell et al. | 07-2003 |
| 6910179 | Pennell et al. | 06-2005 |

6065048

Hiley

05-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-13, 15-16, 18-24, 26-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell et al. (US 6589290, filed 29 October 1999, hereafter Maxwell) and further in view of Pennell et al. (US 6910179, filed 9 November 1999, hereafter Pennell).

As per independent claim 1, Maxwell discloses a method for inserting data into an electronic form having at least one field that is compliant with a standard, the method comprising:

- Providing a data storage location having at least one field that is compliant with the standard, wherein at least one compliant field may have a plurality of field values (column 9, line 36- column 10, line 8)
- Providing a set of rules that select one field value from each compliant database field having a plurality of field values (column 12, lines 51-63)

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- Applying the set of rules to select one field value from each complaint data storage location having a plurality of field values (column 13, line 29- column 14, line 18)
- Matching each compliant data storage location field with the corresponding compliant form field (column 14, line 19-28)
- Inserting each selected field value into the corresponding compliant form field (column 14, lines 29-41)
- Wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database (column 14, line 62- column 15, line 32)
- Whereby a completed form is created (column 8, lines 40-55)

Maxwell fails to specifically disclose storing data within a database. However, Pennell discloses storing form filling data in a database (column 2, line 61- column 3, line 6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Maxwell's method with Pennell's method, since it would have allowed a user an organized method for storing user data.

As per dependent claim 2, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising responsive to application of a rule from the set of rules and selection of a field value, changing values in other related fields (column 14, lines 29-41; column 10, lines 9-29: Here, based upon the rules applied, related fields are similarly filled).

As per dependent claim 3, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising receiving the electronic form from a requester (column 18, lines 35-49: Here, when a user purchases an item, the presentation of a form requiring user information is a request for information from a requester).

As per dependent claim 4, Maxwell and Pennell disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising providing a network as a conduit for receiving the electronic form from the requester (column 12, lines 19-50).

As per dependent claim 5, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising transmitting the completed form across a network (column 20, lines 3-24).

As per dependent claim 6, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising:

- Displaying the plurality of field values in at least one complaint field having a plurality of field values (column 10, lines 9-29)
- Selecting one of the field values so that the selected field value is inserted into the corresponding compliant form field (column 10, lines 9-39)

As per dependent claim 7, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further

discloses providing at least one flag in the electronic form so that the flag determines which field value the rules select from each compliant database field having a plurality of field values (column 12, line 64- column 13, line 14: Here, the control type description specifies what form of data to use in filling the form).

As per dependent claim 8, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method wherein the set of rules further resolve conflicts that may arise among fields (column 12, line 51- column 13, line 28: Here, the data type required to fill a field resolves conflicts between data fields).

As per dependent claim 9, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising transmitting the electronic form to a requestor (column 18, lines 35-49).

As per dependent claim 11, Maxwell and Pennell disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising determining whether each selected field value inserted into the completed form is acceptable (column 13, lines 29-58: Here, the information entered may be verified to ensure that it complies with the rules of the form).

As per independent claim 12, the applicant discloses the limitations similar to those in claim 1. Claim 12 is similarly rejected.

As per dependent claim 13, the applicant discloses the limitations similar to those in claim 2. Claim 13 is similarly rejected.

As per dependent claim 15, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further discloses wherein the electronic form further comprises at least one flag assigning at least one complaint form field to a first category (column 12, line 64- column 13, line 14), and the computer program further comprises:

- Means for assigning a second category to at least one field value in each complaint data storage location filed having a plurality of field values (column 9, line 50- column 10, line 35: Here, the data is categorically sorted)
- Means for comparing the first category with the second category (column 12, line 51- column 13, line 28: Here, the categories of data relates to the type of information that may be filled with the data)
- If the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category (column 12, line 51- column 13, line 28: Here depending upon the type of data required by the control type description, the forms are filled)

As per dependent claim 16, the applicant discloses the limitations similar to those in claim 8. Claim 16 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 9. Claim 18 is similarly rejected.



As per dependent claim 19, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further discloses the method further comprising:

- Means for displaying the plurality of field values in at least one compliant data storage location field having a plurality of field values (column 13, lines 29-39)
- Means for inserting the selected field value into the corresponding compliant form filed (column 13, lines 29-39; column 14, lines 29-41)
- Means for changing at least one other field value associated with a field of the electronic form (column 13, lines 29-39: Here, a user can override the form-filling algorithm by dragging and dropping information into the form fields)

As per dependent claim 20, the applicant discloses the limitations similar to those in claim 11. Claim 20 is similarly rejected.

As per independent claim 22, the applicant discloses the limitations similar to those in claim 1. Maxwell further discloses wherein the first computer is a client computer and the second computer is a remote computer containing forms (column 9, lines 37-61; column 11, line 57- column 12, line 50).

As per dependent claim 23, Maxwell and Pennell disclose the limitations similar to those in claim 22, and the same rejection is incorporated herein. Maxwell further discloses a display device coupled to the controller, wherein the controller is further operable to display the electronic form and at least one field value from each compliant data storage location field having a plurality of field values (column 19, line 9- column 20, line 24; column 10, lines 9-29).

As per dependent claim 24, the applicant discloses the limitations similar to those in claim 6. Claim 24 is similarly rejected.

As per dependent claim 26, Maxwell and Pennell disclose the limitations similar to those in claim 24, and the same rejection is incorporated herein. Maxwell further discloses the method wherein the controller is further operable to change at least one field value in a second data storage location field in response to the selection of a field value from the first compliant data storage location field (column 13, lines 29-39).

As per dependent claim 27, Maxwell and Pennell disclose the limitations similar to those in claim 26, and the same rejection is incorporated herein. Maxwell further discloses the controller operable to transfer the completed form from the first storage device to the second storage device through the communications medium (column 20, lines 3-17).

As per dependent claim 29, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell further discloses wherein the electronic form further comprises at least one flag assigning at least one complaint form field to a first category (column 12, line 64- column 13, line 14), and the computer program further comprises:

- Means for displaying the plurality of field values in at least one compliant data storage location field having a plurality of field values (column 13, lines 29-39)
- Means for a user to select a field value from the first compliant data storage location field having a plurality of field values (column 13, lines 29-39)

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- Means for changing a field value in a second compliant data storage location field in response to the user selecting a field value in the first compliant data storage location field (column 13, lines 29-58: Here, the completed forms that a user fills in, are tracked and changes to field values are stored)
- Means for assigning a second category to at least one field value in each complaint data storage location field having a plurality of field values (column 9, line 50- column 10, line 35: Here, the data is categorically sorted)
- Means for comparing the first category with the second category (column 12, line 51- column 13, line 28: Here, the categories of data relates to the type of information that may be filled with the data)
- If the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category (column 12, line 51- column 13, line 28: Here depending upon the type of data required by the control type description, the forms are filled)
- Means for transmitting the completed electronic form to a requester (column 18, lines 35-49)

Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell and Pennell and further in view of Higley (US 6065048, filed 29 October 1997).

As per dependent claim 28, Maxwell and Pennell disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Maxwell fails to

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specifically disclose use of a MIME protocol. However, Higley discloses use of a MIME protocol (column 6, lines 49-67).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Maxwell and Pennell's program product with Higley's program product, since it would have allowed a user to incorporate a standard protocol into data transfer.

As per dependent claim 30, the applicant discloses the limitations similar to those in claim 28. Claim 30 is similarly rejected.

#### **(10) Response to Argument**

The appellant's initial argument is based upon their belief that the prior art fails to teach a standard which is a protocol extension that specifies the file that may be used in the electronic form in the database (page 10). However, the examiner respectfully disagrees. Maxwell discloses use of a template to determine the type of form to be populated by the data stored in a secure storage medium (column 10, lines 9-29). A plurality of templates exist, each template corresponding to each type of form graphic the user has created (column 10, lines 9-29). For example, the personal information graphic triggers a template defining the protocol that specifies the data to be obtained and used to populate the electronic form (column 10, line 9-29; column 10, line 49-column 11, line 44). Further, the template file contains a regular expression identifying the form fields to be filled with associated text (column 13, line 15-28). Therefore, the

examiner believes Maxwell discloses use of a standard in compliance with the appellant's definition.

The appellant further argues that the examiner has failed to provide proper motivation with respect to claims 28 and 30 (pages 13-15). The examiner respectfully disagree. Maxwell fails to disclose use of the MIME standard which Higley teaches (column 6, lines 49-67). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Maxwell with Higley, since it would have allowed a user to incorporate a standard protocol into data transfer. Further, it would have been obvious to one of ordinary skill in the art to combine Maxwell with Higley, since it would have allowed a user to take advantage of MIME's notoriously well known registration of file types with information about the applications needed to process them thereby allowing for the inclusion of multimedia files.

Finally, the applicant argues that the examiner has relied upon a piecemeal analysis of the claim, thereby using the claim as a roadmap to find prior art components (page 15). The examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
krs

Conferees:

  
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